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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	2002064.127US1	2619
24395	7590	10/18/2007	EXAMINER	
WILMERHALE/DC 1875 PENNSYLVANIA AVE., NW WASHINGTON, DC 20004				KING, ANITA M
ART UNIT		PAPER NUMBER		
3632				
NOTIFICATION DATE			DELIVERY MODE	
10/18/2007			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/910,655	LIEBENDORFER, JOHN E.	
	Examiner	Art Unit	
	Anita M. King	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4,6-10,13-32,36-38 and 42-49 is/are pending in the application.
 - 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) Claim(s) 10,13-23,36,38 and 42-49 is/are allowed.
- 6) Claim(s) 4,6-9,31,32 and 37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

This is a final office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

Election/Restrictions

Claims 24-30 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without traverse** in the reply filed on August 26, 2002.

Cancellation of Claims

Claims 1-3, 5, 11, 12, 33-35, and 39-41 have been canceled per applicant's request.

Claim Rejections - 35 USC § 112

Claims 4, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim 1 clearly indicates that a subcombination is being claimed, e.g., "a system for removably and adjustably mounting a photovoltaic module or other flat panel on a surface...." This language would lead the examiner to believe that the applicant

Art Unit: 3632

intends to claim only the subcombination of "a system," the photovoltaic module or other flat panel and the surface being only functionally recited. This presents no problem as long as the body of the claim also refers to the photovoltaic module/other flat panel and surface functionally, such as, "for attachment to said surface."

The problem arises when the surface is positively recited within the body of the claim, such as, "further wherein the rail is substantially parallel to said surface." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a system and a surface are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the system or the system in combination with the surface.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the system alone or the combination of the system and the surface. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, **the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly**. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,261,625 to Cripe. Cripe discloses a system for removably and adjustable mounting a flat panel (38), the system comprising: a rail (36) formed with at least two tracks (49); wherein the rail is formed with a body having a proximal end, a distal end, and hollow chamber (59) therebetween; wherein the rail is removably mountable on a footing (118), however capable of mounting on a footing grid; wherein the at least two tracks include a channel (53) extending the length of the rail; wherein the channel in the at least two tracks is formed with a slot (formed by element 52) extending the length of the rail, wherein the slot in one of the at least two tracks is formed at substantially a right angle to the slot in any other of the at least two tracks; a plurality of keepers (37) on which to mount the rail; one or more clamps (79 or 122) for connecting the system to a surface; and wherein the one or more clamps include means for connecting the panel to the rail.

Claims 6, 7, 31, 32, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,513,606 to Jones. Jones discloses a system for removably and adjustably mounting a flat panel (42), the system comprising: a rail (36) formed with at least two tracks; wherein the rail is formed with a body having a proximal end, a distal end, and a hollow chamber therebetween; wherein the rail is removably mountable and slidably engageable on a footing (1), however capable of mounting on a

Art Unit: 3632

footing grid; wherein the at least two tracks include a channel (37) extending the length of the rail; a plurality of keepers (47) on which to mount the rail; one or more clamps (5) for connecting the system to a surface, wherein the one or more clamps is formed as a duct with at least two opposing flanges; wherein the opposing flanges of the one or more clamps are substantially parallel to one another; and wherein the one or more clamps include a means for connecting the panel to the rail.

Allowable Subject Matter

Claim 8 (as it depends from claim 4) would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 10, 13-23, 36, 38, and 42-49 are allowed.

Response to Arguments

Applicant's arguments filed July 26, 2007 have been fully considered but they are not persuasive. The rejections against claims 4, 6, 7, 9, 31, 32, and 37 stand.

In response to applicant's argument that Cripe describes a partition construction for buildings, which can be used to partition rooms into various subsections, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's arguments, the recitation wherein the rail is substantially parallel to the surface has not been given patentable weight because the recitation occurs in a functional statement wherein the surface is not positively recited as an element of the claimed invention, thus, the reference to Cripe need only be capable of mounting on a surface where the rail is substantially parallel to the surface and further, this limitation does not yield any unpredictable results in regards to the claimed structure.

In response to applicant's argument that Jones discloses a joint structure for removable partitions or shelving units, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's arguments, the recitation a system for removably and adjustably mounting a photovoltaic module or other flat panel on a surface has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response applicant's argument that Jones does not anticipate independent claims 6 or 31, which both recite that the system is connected to the surface, not merely resting on the surface. Claims 6 and 31 both recite the limitation "one or more clamps for connecting the system to the surface", the term "for" indicates a functional limitation, the surface is not considered as a positively recited element of the claimed invention. Jones need only be capable of having a structure that can connect to a surface. It is a well-known technique that connecting an object to something will improve the stability of the object and since the applicant does not provide any specifics to the surface in the claimed subject matter, the surface itself can be any element and thus, Jones does meet this functional limitation based on the broadest interpretation of the term surface. The rail (36) in Jones is connected to the surface of the junction box (4) in Jones.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anita M. King
Primary Examiner
Art Unit 3632

October 11, 2007